

A **CHINA GREEN FOOD DEVELOPMENT CENTER**
v. CHEONG CHONG FONG
HIGH COURT MALAYA, KUALA LUMPUR
MOHD RADZI HARUN J
[ORIGINATING SUMMONS NO: WA-24IP-15-11-2020]
B 28 MARCH 2023

C **Abstract** – *A registered trademark may be removed from the Register of Trademarks pursuant to s. 46 of the Trademarks Act 2019 in respect of any of the goods and services, in respect of which it is registered, for non-use by the proprietor. The party who applies for the revocation on grounds of non-use has to prove, at the outset, a prima facie case of non-use. Once this is done, the burden falls upon the proprietor of the registered trademark to show evidence of use during the material period of time.*

D **INTELLECTUAL PROPERTY:** *Trademarks – Infringement of – Refusal of application to register trademark for being identical to existing registered trademark – Application for invalidation and/or revocation of registered trademark for non-use – Whether applicant aggrieved person – Whether established prima facie case of non-use by proprietor of registered trademark – Whether invocation of non-use of registered trademark as ground for invalidation statutorily allowed – Trademarks Act 2019, ss. 46 & 47*

F The plaintiff was a specialised agency under the Ministry of Agriculture of the People’s Republic of China responsible for the certification and accreditation of ‘green food’ in China. ‘Green food’ essentially refers to edible agricultural and processed products produced and grown organically, in pollution-free and safe environments and in accordance with prescribed technical specifications and strict quality control. Having acquired an extensive reputation in the quality of its work in the certification and accreditation of green food products, the plaintiff had accordingly registered its ‘green food’ certification and accreditation marks as trademarks in China, Australia, Singapore, the USA, the UK, France, Portugal, Finland, and the Russian Federation. The plaintiff, through its trademark agent in Malaysia, applied to register its trademark in Malaysia under classes 5, 29, 30, 31, 32, and 33. The application was refused by the Registrar of Trademarks for being identical to an existing registered trademark owned by the defendant. Hence, the plaintiff’s application under ss. 46 and 47 of the Trademarks Act 2019 (‘TMA’) for the invalidation and/or revocation of the defendant’s trademark from the Register of Trademarks, *inter alia*, on the ground that the defendant’s trademark had not been put to use in good faith in Malaysia by the defendant for a period of three years since its registration.

Held (dismissing plaintiff's application with costs):

- (1) In order to sustain the application for revocation and invalidation, the court had to resolve the fundamental legal issue as to whether the plaintiff was an aggrieved person within the meaning of ss. 46 and 47, in that, the plaintiff must firstly establish that it possessed the *locus standi*. The plaintiff must assert an infringement of his statutory right which affected the plaintiff's interests substantially or that the plaintiff had some genuine interest in having his legal position declared, even though he could get no other relief. A person is an aggrieved person in a trademark claims when: (i) he has shown that he used his mark as a trademark; (ii) he has a genuine and present intention to use his mark as a trademark; (iii) the use or intention to use of that trademark is in the course of a trade; and (iv) the trade in issue must be one which is the same as or similar to the trade of the owner of the registered trademark that the person wants to have removed from the Register. (paras 16-19)
- (2) The plaintiff failed to fulfil the test, in that, the plaintiff failed to establish its trademark's actual use in Malaysia. The plaintiff further failed to show any evidence of its genuine and present intention to use the plaintiff's trademark as a trademark in the course of a trade which was the same as or similar to the defendant's. The plaintiff was not someone who had some element of legal interest, right or legitimate expectation in its own mark which was being substantially affected by the presence of the defendant's trademark. The plaintiff was not an aggrieved person within the meaning of ss. 46 and 47 of the TMA. On this ground alone, the plaintiff's application was dismissed *in limine*. (para 25)
- (3) As the party who applied for the revocation on the ground of non-use, the plaintiff had to prove, at the outset, a *prima facie* case of non-use. The plaintiff was required to proof its claim of non-use, among others, by conducting a survey, which in turn must fulfil a survey criteria as set out in the 'Whitford Guidelines'. There was no evidence adduced by the plaintiff that it had conducted any such survey, not to mention whether or not it fulfilled the Whitford Guidelines. The plaintiff had therefore failed to establish a *prima facie* case of non-use by the defendant. The burden therefore never shifted to the defendant to rebut it. On the contrary, the defendant had in fact used the defendant's trademark in the course of his business. (paras 28-31)
- (4) An otherwise regularly registered trademark can be invalidated by the court pursuant to sub-ss. 47(1), (2), (3), (5) and (6) of the TMA. Further, s. 53 read together with sub-s. 166(1) provides that in the case of a

- A trademark which had been registered for a period of more than five years – such as the defendant’s trademark – the registration of such trademark shall be deemed conclusive and any challenge against that registration for the purposes of its invalidation can be mounted only on the following grounds: (i) the original registration was obtained by fraud; (ii) the trademark offends paras. 23(5)(a), (c), (d) or (e); or (iii) the trademark was, at the commencement of the proceedings, devoid of distinctiveness of the goods or services of the registered proprietor. The plaintiff’s invocation of the defendant’s non-use of the trademark as a ground for invalidation was statutorily disallowed and was dismissed *in limine*. (paras 32-35)
- (5) The registration would be bound for invalidation if the plaintiff had successfully shown that the Registrar had erred when he allowed the registration of the defendant’s trademark. Paragraph 9 of the Registrar’s statement set out in detail the reasons and grounds considered by the Registrar in allowing the registration of the defendant’s trademark. The Registrar had applied the correct statutory provisions and principles in allowing the registration of the defendant’s impugned trademark and rejecting the plaintiff’s trademark. (paras 36-38)

Case(s) referred to:

- E *Godrej Sara Lee Ltd v. Siah Teong Teck & Anor* [No 2] [2007] 1 LNS 230 HC (*refd*)
Government Of Malaysia v. Lim Kit Siang & Another Case [1988] 1 CLJ 219; [1988] 1 CLJ (Rep) 63 SC (*refd*)
Imperial Group Plc v. Philip Morris Ltd & Anor [1984] 5 WLUK 119 (*refd*)
Lam Soon Edible Sdn Bhd v. Hup Seng Perusahaan Makanan (M) Sdn Bhd [2010] 5 CLJ 975 HC (*refd*)
- F *LB (Lian Bee) Confectionery Sdn Bhd v. QAF Ltd* [2012] 3 CLJ 661 FC (*refd*)
Lim Yew Sing v. Hummel International Sports & Leisure A/S [1996] 4 CLJ 784 CA (*refd*)
Liwayway Marketing Corporation v. Oishi Group Public Co Ltd [2017] 5 CLJ 133 FC (*foli*)
McLaren International Ltd v. Lim Yat Meen [2009] 4 CLJ 749 FC (*refd*)
- G *Mesuma Sports Sdn Bhd v. Majlis Sukan Negara Malaysia; Pendaftar Cap Dagangan Malaysia (Interested Party)* [2015] 9 CLJ 125 FC (*refd*)
Re Arnold D Palmer In The Matter Of Trade Mark Registration No 63249 [1986] 1 LNS 11 (*refd*)
Tan Sri Hj Othman Saat v. Mohamed Ismail [1982] 1 LNS 2 FC (*foli*)

Legislation referred to:

- H Evidence Act 1950, ss. 80, 114
Trademarks Act 2019, ss. 24(1), (2), (3), (4), 46, 47(1), (2), (3), (5), (6), (7), (8), 53(b), 116(1), 141(2)
For the plaintiff - Chung Chee Yien; M/s CY Chung & Assocs
For the defendant - Annamalai Vairavan; M/s S Chandran & Partners
- I *Reported by S Barathi*

JUDGMENT

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Mohd Radzi Harun J:**Introduction**

[1] This is an appeal by the plaintiff against the decision of this court dismissing the plaintiff's application under ss. 46 and 47 of the Trademarks Act 2019 ("TMA") for the invalidation and/or revocation of the defendant's trademark from the Register of Trademarks.

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[2] Below are my reasons why the plaintiff application was dismissed.

Background

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[3] The plaintiff was established in 1992 as a specialised agency under the Ministry of Agriculture of the People's Republic of China responsible for the certification and accreditation of "green food" in China. It is the first agency in China tasked with overseeing organic food standards. Essentially, "green food" refers to edible agricultural and processed products produced and grown organically, in pollution-free and safe environments, and in accordance with prescribed technical specifications and strict quality control.

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[4] Since its establishment, the plaintiff has certified various "green food" products and as an accreditation agency, the plaintiff has also certified food products that have been exported to various parts of the world from China. The plaintiff averred it has acquired an extensive reputation in the quality of its work in the certification and accreditation of green food products.

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[5] The plaintiff has accordingly registered its "green foods" certification and accreditation marks as trademarks in China, Australia, Singapore, the USA, the UK, France, Portugal, Finland, and the Russian Federation. The plaintiff's registered trademark ("plaintiff's trademark") is as follows:

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[6] On 12 June 2019, the plaintiff through its trademark agent in Malaysia, NBS Intellectual Sdn Bhd, applied to register its trademark in Malaysia under classes 5, 29, 30, 31, 32, and 33. The application was refused by the Registrar of Trademarks for being identical to an existing registered trademark owned by the defendant.

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[7] Subsequent thereto, the plaintiff conducted a search on the defendant's trademark and it was uncovered that the application to register the defendant's trademark had been submitted by a company known as

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- A Greenfood Enterprise Sdn Bhd (Greenfood Enterprise) on 24 April 2003 and the same was subsequently accepted for registration on 24 April 2013. The trademark bearing no. 03004810 in class 30 is as shown below:

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- [8] Greenfood Enterprise as the registered proprietor of that trademark had transferred the trademark to the defendant on 3 March 2014. The application for the transfer was made to My IPO on 5 March 2014 and the registration of the trademark in the defendant's name had been effected on 16 December 2014 ("defendant's trademark"). (Refer exh. CCF-1 to the defendant's affidavit affirmed on 14 January 2021).

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The Plaintiff's And Defendant's Cases

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[9] The plaintiff's case is that the defendant's trademark should be invalidated or revoked and removed from the Register of Trademarks pursuant to ss. 46 and 47 of the TMA on the following grounds:

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- (i) the plaintiff is an aggrieved party under ss. 46 and 47 of the TMA because the plaintiff is unable to register the plaintiff's trademark in Malaysia despite the extensive use of the plaintiff's trademark by the plaintiff;

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- (ii) that the defendant's trademark has not been put to use in good faith in Malaysia by the defendant for a period of three years since the registration either by Greenfood Enterprise, which has been dissolved, nor by the defendant, who is an individual and not a business entity;

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- (iii) the newspaper advertisement in the Chinese language which was exhibited by the defendant in his affidavit (refer exh. CCF-2 to the defendant's affidavit affirmed on 14 January 2021) to show proof of his usage of the defendant's trademark cannot be accepted as evidence as the said advertisement remained untranslated and thereby should be expunged;

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- (iv) the registration of the defendant's trademark and the subsequent assignment of that trademark to the defendant by Greenfood Enterprise were invalid as neither the defendant nor Greenfood Enterprise are accredited agency for green food nor possessing the expertise to certify the same; and

- (v) the defendant's trademark is likely to cause confusion and/or deception to the public as it bears striking similarity with the plaintiff's trademark and would wrongly give the impression that the defendant's products or business relate to green products that had been appropriately certificated and accredited as green products from an authorised body such as the plaintiff.

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[10] The defendant relied on two sets of documents as documentary evidence that the defendant has been involved in green food business as early as 2006 and that the defendant's trademark had been used throughout that involvement, either by the defendant or by Greenfood Enterprise. First are the excerpts of various advertisements on the sale of products by Greenfood Enterprise as in exh. CCF-2 to the defendant's affidavit affirmed on 14 January 2021. Second is the invoices/receipts in exh. CCF-3 for sales of certain products by Greenfood Enterprise on various dates between 2012 to 2014. The defendant's trademark is conspicuously depicted in all the advertisements exhibited in the affidavit as proof of continued usage of the defendant's trademark by Greenfood Enterprise and/or the defendant.

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[11] The plaintiff argued that the advertisements cannot be accepted by this court as evidence as they remained in its original language, Chinese language, throughout the course of the proceeding. There was no effort by the defendant to translate the advertisements leaving the court to conjure the meaning depicted in the advertisements. The defendant argued that although some of the newspaper advertisements were not translated into Bahasa Malaysia, the court may still presume the documents to be true pursuant to ss. 80 and 114 of the Evidence Act 1950.

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[12] Apart from the above, the defendant's objection to the plaintiff's invalidation and revocation application was based on the following grounds:

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- (i) refusal of trademark registration by the Registrar of Trademark *per se* does not make the plaintiff an aggrieved person under s. 46 of the TMA;
- (ii) the plaintiff has no *locus standi* to apply for the invalidation and revocation of the defendant's trademark and was abusing the process by attempting to register an identical or confusingly similar trademark;
- (iii) no survey was conducted by the plaintiff pursuant to Whitford guidelines to prove the non-use of the defendant's trademark within three years of the defendant's registration. This burden lies on the plaintiff; and
- (iv) section 24 of the TMA has clearly indicated that the Registrar of Trademark shall refuse to register a trademark if there is an identical and/or well-known trademark that was registered in Malaysia. As such, the Registrar's refusal against the plaintiff's application was correct and lawful.

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A Findings

Preliminary Issue

[13] CCM search conducted on Greenfood Enterprise by the plaintiff as shown in exh. ZHR-6 to the plaintiff's affidavit affirmed on 10 October 2020 revealed that the company was incorporated in Malaysia on 20 July 2000 and was formerly known as TLJ Food Industries Sdn Bhd. This company changed its name to Greenfood Enterprise on 9 May 2003. The directors of Greenfood Enterprise are Chong Yoon Choy and Lim Chong Heng and its shareholders are Cheong Kah Woh (holding five shares), Cheong Kah Foo (five), Cheong Chong Fong (defendant) (five), Chong Yoon Choy (699,990) and Lim Chong Heng (299,990). That CCM search which was conducted on 1 September 2020 showed the status of Greenfood Enterprise as dissolved but the dissolution date is not stated.

[14] Although this search revealed a financial information of the company for financial year 2005 which was tabled in 2007, and not the subsequent years, it cannot be presumed that the dissolution of Greenfood Enterprise occurred in 2008. This is particularly so when the registration of the defendant's trademark which was filed on 24 April 2003 had been approved and registered by MyIPO in the name of Greenfood Enterprise on 24 April 2013. The application at MyIPO for the registration of the transfer of the defendant's trademark from Greenfood Enterprise to the defendant's name was made to MyIPO some 11 months after that, on 5 March 2014, and the registration of the trademark in the defendant's name had been effected on 16 December 2014.

[15] Taking into account the above fact coupled with the evidence through the receipts and invoices adduced by the defendant showing Greenfood Enterprise continued its trading until 2014, this court concludes that the dissolution of Greenfood Enterprise occurred the earliest on 16 December 2014. In any event, this issue bears no significance to the plaintiff's application and plays no legal impediment to the defendant's objection to the same.

Is Plaintiff An "Aggrieved Person"?

[16] Before determining whether the plaintiff's application for revocation and invalidation could be sustained, ss. 46 and 47 instructs this court to resolve the fundamental legal issue as to whether or not the plaintiff is an aggrieved person. If the answer to this question is in the affirmative, only then will this court move on to consider the substantive issues of revocation and invalidation. On the contrary, if the answer to that question is in the negative, then the application shall be dismissed *in limine*.

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[17] For the plaintiff to pass the test and being recognised as an “aggrieved person” within the meaning of ss. 46 and 47, it must firstly establish that it possesses the *locus standi*.

[18] This court apply the principle set out by Eusoffe Abdoolcader J (as His Lordship then was) in *Tan Sri Hj Othman Saat v. Mohamed Ismail* [1982] 1 LNS 2; [1982] 2 MLJ 177, Abdoolcader J (as His Lordship was then) that in determining one’s *locus standi* in a matter involving declarations (such as the current case before this court), the plaintiff must assert an infringement of his statutory right of a statute which affects the plaintiff’s interests substantially or that the plaintiff has some genuine interest in having his legal position declared, even though he could get no other relief. This proposition was expounded further by the Supreme Court in *Government Of Malaysia v. Lim Kit Siang & Another Case* [1988] 1 CLJ 219; [1988] 1 CLJ (Rep) 63; [1988] 2 MLJ 12. The Federal Court having set out in great detail the history that set out the principle on *locus standi* in England, held that the “sufficient and special interest” test applies in Malaysia, and concluded:

Back in Malaysia, since we have not accepted O. 53 and its statutory underpinning (*ie*, s. 31 of the Supreme Court Act), there is no justification therefore for us to depart from the rule of *locus standi* accepted by the highest court in England prior to O. 53.

... Every legal system has a built-in mechanism to protect its judicial process from abuse by busy-bodies, cranks and other mischief-makers by insisting that a plaintiff should have special interest in the proceedings which he institutes. This special interest is a nexus between him and the party against who he brings his complaints to court and is known as *locus standi*.

[19] Within the context of trademark claims, the *locus standi* principle is further confined statutorily to cover persons who are aggrieved by actions claimed to have affected his intellectual property rights. In the High Court of Singapore case of *Re Arnold D Palmer In The Matter Of Trade Mark Registration No. 63249* [1986] 1 LNS 11; [1987] 2 MLJ 681, Chan Sek Keong J (as His Lordship then was) set up in pronounced details, to the great benefits of this court and many others that referred to His Lordship’s scholarly works in this case, the development of jurisprudence to determine who is that “aggrieved person” *vis-a-vis* trademark claims. The principle that can be distilled from His Lordship’s decision is that a person is an aggrieved person in a trademark claim when:

- (i) he has shown that he used his mark as a trademark;
- (ii) he has a genuine and present intention to use his mark as a trademark;
- (iii) the use or intention to use of that trademark is in the course of a trade;
- (iv) the trade in issue must be one which is the same as or similar to the trade of the owner of the registered trademark that the person wants to have removed from the Register.

- A [20] *Re Arnold D Palmer* was referred to with approval by the Federal Court in *McLaren International Ltd v. Lim Yat Meen* [2009] 4 CLJ 749. The Federal Court concluded that whether a person passes the test of a person aggrieved as laid down in *Re Arnold D Palmer* is a question of fact. The Federal Court in *McLaren* referred with affirmation Chan Sek Keong J's finding in
- B *Re Arnold Palmer* that A's claim that he is an aggrieved person in a trademark proceeding will fail unless A can show that he has used his trademark in the course of a trade which is the same as or similar to the trade of B, the owner of the registered trademark that A wants to have removed from the Register.
- (See further affirmation of *McLaren* in *LB (Lian Bee) Confectionery Sdn Bhd v. QAF Ltd* [2012] 3 CLJ 661; [2012] 4 MLJ 20; *Mesuma Sports Sdn Bhd v. Majlis Sukan Negara Malaysia; Pendaftar Cap Dagangan Malaysia (Interested Party)* [2015] 9 CLJ 125; [2015] 6 MLJ 465; and *Liwayway Marketing Corporation v. Oishi Group Public Co Ltd* [2017] 5 CLJ 133; [2017] 4 MLJ 141).
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- D [21] The defendant argued that the plaintiff's case should be dismissed *in limine* for its failure to pass the aggrieved person test as laid out in the authorities cited above, based on the following reasons:
- E (i) the plaintiff has not adduced any evidence to substantiate its claim that the defendant had not used the defendant's trademark. Applying the Federal Court decision in *Liwayway Marketing Corporation*, the plaintiff is required to prove its claim of non-use, among others, by conducting a survey, which in turn must fulfil survey criteria as set out in the "Whitford Guidelines" by Whitford J in *Imperial Group Plc v. Philip Morris Ltd & Anor* [1984] 5 WLUK 119;
- F (ii) in the absence of such survey, the burden always lies on the plaintiff to prove defendant's non-use of the defendant's trademark: *Godrej Sara Lee Ltd v. Siah Teong Teck & Anor (No 2)* [2007] 1 LNS 230; [2007] 3 MLRH 683. The plaintiff totally failed to discharge this burden when the
- G defendant adduced his evidence of the advertisements and invoices/receipts which had all showed defendant's continued usage of the defendant's trademark;
- H (iii) sub-section 47(3) read together with s. 24 of the TMA provides clear powers to the Registrar of Trademarks to invalidate a registered trademark if there was an earlier trademark registered under s. 24(1), (2) or (3), or there was an earlier right to a trademark under s. 24(4). The plaintiff failed to provide any evidence to allow the Registrar to invoke this provision;
- I (iv) the plaintiff failed to provide any evidence that it has trading interest in Malaysia, despite the fact that the plaintiff may be a big player in the green food industry in Australia, Singapore, China, USA and other parts of the world.

[22] This court agrees with the defendant that there is no evidence adduced before this court that the plaintiff has used the plaintiff's trademark in Malaysia in the trading of its goods or services. But the question is does that mean that the plaintiff had failed to fulfil the threshold of "the trademark in issue must be used in the course of a trade that is the same as or similar to the trade of the owner of the registered trademark that the person wants to have removed from the Register", as established in *Re Arnold D Palmer and McLaren*? The answer is in the negative.

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[23] If the plaintiff failed to establish the actual use of the plaintiff's trademark in Malaysia, the plaintiff shall prove to the satisfaction of this court its genuine and present intention to use in Malaysia the plaintiff's trademark in trading goods that fall within the same class(es) of the defendant's.

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[24] This court agrees with the defendant that the plaintiff failed to provide any evidence that it has trading interest in Malaysia, despite the fact that the plaintiff may be a big player in the green food industry in Australia, Singapore, China, USA and other parts of the world. This court further found no shred of evidence adduced by the plaintiff that it will embark on its plan to invest in the Malaysian market to trade in goods and services bearing the plaintiff's trademark. That means the plaintiff failed to prove to the satisfaction of this court its genuine and present intention to use in Malaysia the plaintiff's trademark in trading goods that fall within the same class(es) of the defendant's.

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[25] Having considered all the above, this court concluded that the plaintiff failed to fulfil the test laid down in *McLaren*. The plaintiff failed to establish its actual use of the plaintiff's trademark in Malaysia. The plaintiff further failed to show any evidence of its genuine and present intention to use the plaintiff's trademark as a trademark in the course of a trade which is the same as or similar to the defendant's. The plaintiff is not someone who has some element of legal interest, right or legitimate expectation in its own mark which is being substantially affected by the presence of the defendant's trademark. The plaintiff is therefore a busybody, a crank or a mischief-maker, having failed to show its special interest in the proceedings which it instituted against the defendant. The plaintiff is not an aggrieved person within the meaning of ss. 46 and 47 of TMA 2019. On this ground alone, the plaintiff's application is dismissed *in limine*. However, this court will proceed to briefly deal with the other grounds intimidated by the plaintiff, on the assumption that this court decides that the plaintiff is an aggrieved person.

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Revocation Under Section 46 Of The TMA

[26] It is important to note that the registered trademark will not be revoked on the ground of non-use under paras. 46(1)(a) and (1)(b) if the proprietor is able to show evidence of use after the period of three years, but before the date of the application for revocation. However, any such use will

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A be disregarded unless the proprietor can show that preparations for such use began before the proprietor became aware that the application for expungement might be made.

B [27] The law is settled that a registered trademark may be removed from the register pursuant to s. 46 of the TMA in respect of any of the goods and services in respect of which it is registered for non-use by the proprietor. This provision may be invoked if it is shown that:

C (i) the trademark was registered without an intention in good faith to use it in relation to such goods and services and there has been no such use in good faith up to the date one month before the date of the application for expungement; or

(ii) up to one month before the date of the application for expungement, there was no good faith use of the registered trademark for a continuous period of not less than three years.

D [28] The principle as laid down by Ramly Ali J (as His Lordship then was) in *Godrej Sara Lee Ltd v. Siah Teong Teck & Anor (No 2)* [2007] 1 LNS 230; [2007] 7 MLJ 164, is that as the party who applies for the revocation on ground of non-use the plaintiff has to prove at the outset a *prima facie* case of non-use. Once this is done, the burden falls upon the defendant as the registered proprietor to show evidence of use during the material period of time.

F [29] This court agrees with the defendant's counsel that following the decision of the Federal Court in *Liwayway Marketing Corporation*, the plaintiff is required to proof its claim of non-use, among others, by conducting a survey, which in turn must fulfil survey criteria as set out in the "Whitford Guidelines" by Whitford J in *Imperial Group Plc v. Philip Morris Ltd & Anor* [1984] 5 WLUK 119. In *Lam Soon Edible Sdn Bhd v. Hup Seng Perusahaan Makanan (M) Sdn Bhd* [2010] 5 CLJ 975; [2010] 4 MLJ 702, Azahar Mohamed J (as His Lordship then was) reiterated the decision of the Court of Appeal in *Lim Yew Sing v. Hummel International Sports & Leisure A/S* [1996] 4 CLJ 784; [1996] 3 MLJ 7 that survey evidence must meet certain minimum requirements as set out in the Whitford Guidelines namely:

G (i) the selected interviewees must represent a relevant cross-section of the public;

H (ii) the size must be statistically significant;

(iii) the survey must be conducted fairly; and

I (iv) the totality of the answers must be disclosed and made available to the defendant.

[30] There was no evidence adduced by the plaintiff that it had conducted any such survey, not to mention whether or not it fulfils the Whitford Guidelines. The plaintiff had therefore failed to establish a *prima facie* case of non-use by the defendant. The burden therefore never shifted to the defendant to rebut it.

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[31] This court concluded that the plaintiff had failed to proof that the defendant's trademark had not been put to use in good faith in Malaysia and that the defendant had not provided proper reasons for such non-use. On the contrary, having accepted the evidence adduced by the defendant, this court concluded that the defendant had in fact used the defendant's trademark in the course of his business.

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Invalidation Under Section 47 Of The TMA

[32] An otherwise regularly registered trademark can be invalidated by court pursuant to sub-ss. 47(1), (2), (3), (5) and (6) of the TMA 2019 when the court is satisfied that the aggrieved person successfully shows that:

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- (i) the trademark in issue was registered in breach of s. 23, unless the opposite party can bring contradictory evidence showing that the registration of the impugned trademark has acquired a distinctive character after its registration in consequence of its use in relation to the goods or services for which it is registered;
- (ii) there was an earlier trademark under sub-ss. 24(1), (2) or (3); or an earlier right under sub-s. 24(4), unless the opposite party brings evidence that the proprietor of that earlier trademark or earlier right has consented to the registration;
- (iii) there had been no honest concurrent use of the impugned trademark and the earlier trademark or other earlier right; or
- (iv) there was fraud in the registration or that the registration was obtained by misrepresentation.

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[33] Sub-section 47(7) further provides that if the court found the existence of the ground of invalidity in respect of only some of the goods or services for which the trademark is registered, the trademark shall be declared invalid as regards those goods or services only. Sub-section 47(8) provides that where the registration of trademark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made, but this shall not affect transactions past and closed.

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[34] Section 53 read together with sub-s. 166(1) provides that in the case of a trademark which had been registered for a period of more than five years – such as the defendant's trademark – the registration of such trademark shall be deemed conclusive and any challenge against that registration for purposes of its invalidation can be mounted only on the following grounds:

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- A (i) the original registration was obtained by fraud;
(ii) the trademark offends para. 23(5)(a), (c), (d) or (e)¹; or
(iii) the trademark was, at the commencement of the proceedings, devoid of distinctiveness of the goods or services of the registered proprietor.
- B [35] Based on the above, the plaintiff's invocation of the defendant's non-use of the defendant's trademark as a ground for invalidation is statutorily disallowed and is dismissed *in limine* without this court having to look at the merit of the application. With that, this court only focused on the second ground cited by the plaintiff to invalidate the defendant's trademark will
- C likely deceive or cause confusion to the public due to its resemblance or similarity with the plaintiff's trademark. Although not specifically cited in the plaintiff's application, this court resolved that this second ground is premised on para. 23(5)(a) read together with s. 53(b) of the TMA.
- D [36] If the plaintiff successfully showed that the Registrar had erred when he allowed the registration of the defendant's trademark despite the existence of this ground, that registration is bound for invalidation.
- E [37] I had considered the Registrar's statement dated 27 January 2022 issued under the instruction of this court pursuant to sub-s. 141(2) of the TMA. Paragraph 9 of the Registrar's statement sets out in detail the reasons and grounds that were considered by the Registrar when he allowed the registration of the defendant's trademark. On the issue of likelihood of deception of confusion to the public, the Registrar stated the following:
- 9.4 Tidak menyerupai atau hampir menyerupai cap dagangan terdahulu
- F 9.4.1 Menjadi tugas utama pihak Pendaftar untuk memastikan cap dagangan yang dimohon tidak menyerupai atau hampir menyerupai cap dagangan-cap dagangan yang terdahulu. Perkara ini ditegaskan di seksyen 19 ACD 1976 seperti yang dijelaskan di perenggan 6.4 di atas.
- G 9.4.2 Carian dan pemeriksaan telah dilakukan ke atas Cap Dagangan Berdaftar tersebut bagi menentukan sama ada ianya adalah serupa atau hampir menyerupai cap terdahulu. Memandangkan Cap Dagangan Berdaftar ini mengandungi perkataan dan elemen figuratif, Pendaftar telah menjalankan dua bentuk carian yang berbeza iaitu carian bagi cap dagangan yang mengandungi perkataan telah dibuat dengan menggunakan sistem carian berkomputer yang dikenali sebagai Common
- H Software (CS). Manakala carian bagi cap dagangan yang mengandungi elemen figuratif telah dilakukan secara manual dengan membuat perbandingan di antara borang permohonan Cap Dagangan Berdaftar tersebut dengan kad indeks yang berada dalam simpanan dan rekod Pendaftar.
- I 9.4.3 Kad indeks ini mengandungi maklumat terperinci mengenai sesuatu cap dagangan yang telah dipohon terlebih dahulu daripada Cap Dagangan Berdaftar ini. Kad indeks ini adalah dikehendaki difailkan oleh setiap pemohon semasa membuat pemfailan permohonan kepada Pendaftar.

9.4.4 Berdasarkan carian yang dilakukan, pihak Pendaftar mendapati bahawa Cap Dagangan Berdaftar tersebut tidak serupa (identical) atau hampir menyerupai (similar) dengan mana-mana cap dagangan terdahulu. Oleh itu, Cap Dagangan Berdaftar ini tidak berkonflik dengan cap dagangan terdahulu dan tiada bantahan dikenakan di bawah seksyen 19 ACD 1976.

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[38] Having considered the Registrar's statement in its entirety including the relevant paragraph above, I am satisfied that the Registrar had applied the correct statutory provisions and principles in allowing the registration of the defendant's impugned trademark on 24 April 2003, and his rejection of the plaintiff's trademark (see exh. ZHR-4 of the plaintiff's affidavit dated 10 October 2020).

B

C

Conclusion

[39] Premised on the aforesaid grounds, I dismissed the plaintiff's application with costs of RM10,000.

D

Endnote:

1. Paragraph 23(5)(a): if the use of the trademark is likely to deceive or cause confusion to the public or contrary to any written law; para. 23(5)(c): the trademarks are contrary to public interest or to morality; para. 23(5)(d): the trademarks contain or consist of any scandalous or offensive matter or would otherwise not be entitled to protection by any court of law; para. 23(5)(e): the trademarks contain a matter which is in the opinion of the Registrar is or might be prejudicial to the interest or security of the country.

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